

Serial Number: 09/884,600

Docket Number: 10011123-1

**REMARKS**

Upon entry of this Response, claims 1-24 remain pending in the present application. Claims 1, 8, 15, and 22 have been amended herein. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, claims 1-3, 8-10, 15-17, and 22 -24 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,714,968 issued to Prust (hereafter "Prust"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). Applicant asserts that Prust fails to show or suggest each of the elements of claims 1-24 in view of amendments to claims 1, 8, 15, and 22. Accordingly, Applicant requests that the rejection of claims 1-24 be withdrawn for the reasons that follow.

Claim 1 has been amended herein to recite as follows:

1. A document retrieval method, comprising:
  - receiving a request email message from a requesting device via a network, the request email message embodying a document request;
  - determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device;
  - automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address;
  - automatically generating a reply email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the originator address on the network, the reply email message being addressed to the originator address; and
  - automatically transmitting the response email message to the destination address on the network.

As described above, claim 1 further comprises the elements of "determining from the requesting address whether a destination address on the network to which at least one document specified in the document request is to be sent is to a third party address or an originator address on the network, where the originator address is associated with the original requesting device." In this respect, the present

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method contemplates the step of determining whether the documents are to be sent to the original requesting device or to a third party address based upon the information provided in the request email message.

Also, claim 1 has been amended to include the element of "automatically generating a forwarding email address with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email address being addressed to the third party address." In this respect, if it is determined that one or more documents is to be sent to a third party address as determined by the information and the request email message, then a forwarding email message is generated in which the document is sent to the third party address. In this respect, the third party address is obtained from the request email message and placed in the "from" field of the email.

Claim 1 has been further amended to indicate that a reply email message is generated if one or more documents specified in the document request is to be sent to the originator address (i.e. back to the requesting device). In this respect, the email address placed in the "from" address field of the reply email message is the address of the requesting device that is located in the "to" field of the requesting email message. Thereafter, the response email message is transmitted to the destination address on the network.

Applicant asserts that Prust fails to show or suggest each of these elements of claim 1 as amended. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn. In addition, Applicant also requests that the rejection of claims 8, 15, and 22 be withdrawn for the reasons described above.

In addition, in item 5 of the Office Action, claims 4, 11, and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Prust in view of U.S. Patent 6,084,952 issued to Beerman, Jr., et al. (hereafter "Beerman"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant asserts that the cited combination of Prust and Beerman fails to show each of the elements of claims 4, 11, and 18 as depending from claims 1, 8, and 15. Accordingly, Applicant requests that the rejection of claims 4, 11, and 18 be withdrawn for the same reasons described above with respect to claim 1, 8 and 15.

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Next, in item 6, claims 5, 12, and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Prust in view of International Patent Publication No. WO01-33874 published by Cho, et al. (hereafter "Cho"). Applicant asserts that the cited combination of Prust and Cho fails to show each of the elements of claims 5, 12, and 19 as depending from claims 1, 8, and 15. Accordingly, Applicant requests that the rejection of claims 5, 12, and 19 be withdrawn for the same reasons described above with respect to claim 1, 8 and 15.

In item 7 of the Office Action, claims 6, 7, 13, 14, 20, and 21 have been rejected under 35 U.S.C. §103(a) over Prust, Cho, and U.S. Patent 6,212,268 issued to Nielsen (hereafter "Nielsen"). Applicant asserts that the cited combination of Prust, Cho, and Nielsen fails to show each of the elements of claims 6, 7, 13, 14, 20, and 21 as depending from claims 1, 8, or 15. Accordingly, Applicant requests that the rejection of claims 6, 7, 13, 14, 20, and 21 be withdrawn for the same reasons described above with respect to claim 1, 8 and 15.

### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

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